

REMARKS

The abstract has been replaced with a new abstract. Support for this amendment can be found in the pending claims.

Claim 10 was amended to correct a grammatical error, i.e., “and” was changed to “an.”

Claim 20 was amended to delete an alternate expression for cedar oil, i.e., “hinoki.”

It is submitted that no new matter has been introduced by the foregoing amendments. Approval and entry of the amendments is respectfully solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned “Version with markings to show changes made.”

Specification Objections

The Examiner objected to the abstract.

The Examiner’s careful review of the abstract is most appreciated. The abstract has been rewritten in an attempt to conform to the Examiner’s recommendation in Paper No. 3 at page 3. The record should affirmatively reflect that “[t]he abstract intended nor designated for use in interpreting the scope or meaning of the claims 37 CFR § 1.72(b).” MPEP § 608.01(b) at 600-63 (8th Ed., August 2001).

It is believed that the abstract is now in conformity with the requirements. Accordingly, it is respectfully submitted that the Examiner remove this ground of objection.

Claim Objections

Claims 10 and 20 were objected to for formal reasons. (Paper No. 3 at 3.)

Claim 10 was objected to because in line 2 the term “and” before “effective” should be replaced with the term --an--.

The Examiner’s careful review of the claims is most appreciated. Claim 10 has been amended accordingly. Withdrawal of this ground of objection is respectfully solicited.

Claim 20 was objected to because in line 3 the term “(hinoki)” was required to be deleted. Claim 20 has been amended accordingly. Withdrawal of this ground of objection is respectfully solicited.

Claims 6 and 23 were objected to under 37 CFR § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The Examiner asserted that claims 6 and 23 recite method steps that fail to further limit the structural or physical characteristics of the claimed article. (Paper No. 3 at 3.)

The objection is traversed for the following reasons.

The essential oil can be added prior to, during, or post manufacturing. The location of the oil in the final product can be dependent on when the oil was added to the sanitary napkin. While not being limited, the objected claims require combining the essential oil with any element prior to manufacturing the sanitary napkin. It may not be possible, for example, to combine an essential oil with an adhesive post manufacturing of the sanitary napkin. Therefore, it is submitted that such claims do limit the structural and/or physical characteristics of the claimed product. For these reasons, the objection to claims 6 and 23 is improper and should be withdrawn.

Anticipation Rejection

Claim 1 was rejected under 35 USC §102(b) as anticipated by Ginocchio., US Patent No. 4,237,591("Ginocchio"). (Paper No. 3 at 4.)

For the reasons set forth below, the rejection, respectfully is traversed.

Ginocchio discloses a sanitary napkin that is provided with a perfume. (Col. 2, Ins. 24-29.) The perfume is made of a formulation having an essential oil, solvents, and other additives designed to provide the perfume with desired properties. (Col. 2, Ins. 38-41.) The amount of perfume used was disclosed as being 0.02 to 0.08 g/napkin. (Col. 5, Ins. 19-22.) A particular mini-pad was disclosed as weighing about 3 g. (Col. 6, Ins. 21-28.)

In making the rejection, the Examiner contended that "Ginocchio discloses sanitary napkins provided with a liquid perfume which comprises essential oils, solvents and other additives. Please see col. 2, Ins. 39-41." (Paper No. 3 at 4.)

As is well settled, it is incumbent upon the Examiner to *identify wherein each and every facet* of the claimed invention is disclosed in the applied reference. The Examiner is required to point to the disclosure in the reference "*by page and line*" upon which the claim allegedly reads.

At the outset, it is not seen where Ginocchio discloses liquid perfume. The Examiner cited column 2, lines 39-41, to support the asserted fact of a "liquid" perfume. However, the cited passage only discloses a "perfume" composition. The Examiner is asked to provide further details on this factual finding in the next paper issued in the captioned application.

Additionally, the rejection failed to identify where in Ginocchio each and every element of claim 1 is shown. The Examiner failed to show where in Ginocchio there is a disclosure that the essential oil disclosed therein was in an effective amount to provide an

aroma and to inhibit microbial growth. That was the Examiner's burden. Because the Examiner failed to meet that burden, the rejection is improper and should be withdrawn.

Obviousness Rejection

Claims 19-23 and 6-11 were rejected under 35 USC §103(a) as being unpatentable over Ginocchio, in view of Engle, US Patent No. 3,819,405, ("Engle") and Hooper, US Patent No. 4,343,783 ("Hooper"). (Paper No. 3 at 4.)

For the reasons set forth below the rejection, respectfully is traversed.

Ginocchio's disclosure set forth above is incorporated herein by reference.

Engle discloses impregnating water insoluble synthetic resins with a volatile substance, e.g., an essential oil. (Col. 2, lns. 17-21.) Engle discloses that the essential oil include oils of various fruits, e.g., apple, cherry, pineapple, etc., oils of various woods, e.g., cedar, pine, briar, and the like, oils of various flowers, e.g., roses, violets, tobacco flowers, and the like, and other such fragrances, e.g., peppermint, menthol, camphor, methyl salicylate, eucalyptus, parachlor benzenes, acetates, and in general those essential oils, i.e., hydro carbons, alcohols, aldehydes, esters, terpenes, tars, phenols, thymols, etc. (Col. 3, lns. 26-37.) The essential oil was disclosed as being an emulsion containing a surfactant. (Col. 3, lns. 38-40.) Engle further discloses that an antimicrobial agent, which can be readily impregnated into a preformed synthetic resin by the emulsion method described in 2-ethyl hexyl salicylate. (Col. 6, lns. 38-40.) An example of an emulsion having purported medical or therapeutic effect was disclosed as having 20 parts of an essential oil, 5 parts of surfactant, 3 parts 2-ethyl hexyl salicylate, and 150 parts water. (Col. 6, ln. 58 – col. 7, ln. 2.) 2-ethyl hexyl salicylate was disclosed as being an anti-microbial agent. (Col. 7, lns. 15-27.) Engle discloses that such an emulsion, e.g., essential oil, surfactant, and 2-ethyl hexyl salicylate can be used in sanitary napkins. (Col. 7, lns. 28-32.)

Hooper discloses a deodorant disposable porous article having a porous substrate with from about 0.001 to 10 % by weight of a deodorant composition. (Col. 1, lns. 41-45.) The deodorant composition includes from 45-100% by weight deodorant components, which are classified into six classes. (Col. 1, lns. 45-58.) Class 2 was disclosed as including essential oils. (Col. 1, ln. 53.) Sanitary napkin covers and pads were disclosed as being an example of a disposable porous article. (Col. 10, lns. 53-62.)

In making the rejection, the Examiner contended that "Ginocchio discloses sanitary napkins provided with a liquid perfume which comprises essential oils, solvents and other additives. Please see col. 2, lns. 39-41." (Paper No. 3 at 5.) The Examiner acknowledged,

however, that Ginocchio differs from the presently claimed invention in that Ginocchio does not disclose "Applicant's claimed essential oils (claim 20)."

To fill the acknowledged gap, the Examiner relied upon (1) Engle as disclosing "impregnating sanitary napkins with essential oils, such as cedar oil, so as to provide a pleasant fragrance" and (2) Hooper as disclosing deodorant disposable porous articles, such as sanitary napkins and their covers, wherein these napkins and covers are impregnated with essential oils comprising clove leaf oil, thyme oil, and cedar atlas oil." (Paper No. 3 at 5.)

The Examiner then concluded that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sanitary napkin of Ginocchio by impregnating the napkin with essential oils like cedar oil, thyme oil, or clove oil as taught by Engle and Hooper because one of ordinary skill in the art would reasonably expect the resulting sanitary napkin to suppress or eliminate any malodors associated with the use of a sanitary napkin." (Paper No. 3 at 5.)

With respect to the claimed concentration of essential oils, the Examiner concluded that "it would have been obvious to one of ordinary skill in the art to further modify the sanitary napkins of the prior art to provide a concentration of essential oils sufficient to eliminate odors" "since pleasant aromas are often associated with the amount of essential oil present."

Moreover, the Examiner concluded that the use of rosemary oil would have been obvious and "well within the capability of the skilled artisan."

The Examiner also concluded that "determining the location where the essential oil is contained in the sanitary napkin is obvious and well within the capability of the skilled artisan." The Examiner further concluded that "one of ordinary skill in the art would be motivated to place the essential oils in an area that would provide for optimum elimination of malodorous substances." (Paper No. 3 at 6.)

Obviousness, however, cannot be based upon speculation. Nor can obviousness be based upon possibilities or probabilities. As is fundamental, a *prima facie* case of obviousness must be based on facts, "cold hard facts." When the rejection is not supported by facts, it cannot stand.

The arguments presented above with respect to the anticipation rejection apply to the obviousness rejection, as well. Engle and Hooper, alone or together, do not close the gaps left by Ginocchio. For example, the Examiner failed to show where in Ginocchio, Engle, and

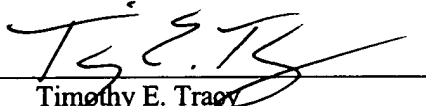
Hooper there is a disclosure, suggestion or motivation of, among other things, an effective amount of essential oil to provide aroma and to inhibit microbial growth.

In fact, it is submitted, Engle specifically teaches away from the claimed invention. Specifically, Engle discloses that, an additional component, 2-ethyl hexyl salicylate, is **added as an antimicrobial** agent for use in sanitary napkins. Therefore, it is submitted that the combination of Ginocchio, in view of Engle and Hooper relied on by the Examiner discloses that an additional component is needed to inhibit microbial growth. This in fact further attests to the patentable nature of the claimed invention. For these reasons, the rejection is improper and should be removed.

Accordingly, for the reasons set forth above, entry of the amendments, withdrawal of the rejections, and allowance of the claims is respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

Respectfully submitted,

By: _____


Timothy E. Tracy
Reg. No. 39,401

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-6586
Dated: January 18, 2002

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

The abstract was replaced with the following rewritten abstract:

--The invention relates to sanitary napkins having an effective amount of essential oil to provide an aroma and inhibit microbial growth and associated methods.--

In the Claims:

Claim 10 was amended as follows:

10. (Amended) A sanitary napkin contained with wrapping material, wherein the wrapping material contains an~~and~~ effective amount of essential oil to provide an aroma and inhibit microbial growth.

Please amend claim 20 as follows:

20. (Amended) A sanitary napkin of claim 19, wherein the essential oil is selected from the group consisting of rosemary oil, clove oil, ginger oil, turmeric oil, chamomile oil, lemon grass oil, thyme oil, achillea oil, thulasi oil, clary sage oil, cedar (~~hinoki~~) oil, and mixtures thereof.